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09/755,650	01/05/2001	Brett B. Stewart	5285-00106	7041

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

2162

DATE MAILED: 01/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AG

Office Action Summary

Application No.
09/755,650

Applicant(s)

Stewart

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 5, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 5, 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 20) ☐ Other:

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "memory 27" as described on lines 38 and 39 in column 10 of the specification is not shown in Figure 1. Correction is required.

Claim Objections

2. Claims 30, 44, and 45 are objected to because of the following informalities:
Claim 30 should depend on Claim 23, not Claim 13;
Claim 44 should depend on Claim 43, not Claim 1; and
Claim 45 should depend on Claim 43, not Claim 1.

Appropriate correction is required.

3. Claims 14, 24, 25, and 45 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

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Claim 14 consists of the information provider selecting the information to provide to the mobile unit based on the past transactions of the user of the mobile unit. Claim 13, upon which Claim 14 depends, already includes the limitation that the information provider provides said information dependent upon the past transactions of the user of the mobile unit. It is inherent in Claim 13 that in order for the information provider to provide the information to the user of the mobile unit, the information provider must have already selected the information to provide. In both instances the information is based (dependent) upon the past transactions of the user. Therefore, the Examiner finds no patentable distinction between the two claims.

Claims 24 and 25 both depend upon Claim 23. Claim 23 includes the limitation that the information provider transmits information to the portable computing device, wherein the content of the information is dependent upon past transaction of the user of the portable device. Claim 24 includes the limitation that the information provider selects said information prior to transmitting. Claim 25 includes the limitation that the information provider accesses past transaction information of the user and selects the said information based on the past transaction of the user. As discussed above, it is inherent that in order for the information provider to transmit the information to the user, the information provider must have already selected the information to provide. Likewise, since Claim 23 includes the limitation that the information is dependent upon past transactions of the user, it is inherent that the information provider must have accessed information about the past transactions of the user. Without accessing the past transaction information of the user, the information provider could not base the selection of the information

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upon such information; and without selecting the information to transmit to the user, the information provider could not transmit such information. Therefore, the Examiner finds no patentable distinction between Claims 24 or 23 and Claim 23.

Claim 45 depends upon Claim 1 and consists of the further limitation that “the past transactions include past commercial activities of the user”. Claim 4 also depends on Claim 1 and includes the exact same further limitation of Claim 45. Therefore, the Examiner finds no patentable distinction between the Claim 45 and Claim 4. The Examiner further notes that as discussed in paragraph 2 above, it is believed that Claim 45 should depend upon Claim 43, not Claim 1. Such a change in dependency would overcome this objection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10, 41, 44, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 10 is dependent upon Claim 8, which is a system for providing information to users of mobile (portable) units. Claim 10 is directed towards a database containing information for

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managing a network, such as tracking the network communication links, characteristics of network elements, network performance statistics, etc. There is no connection between the information in this database and the information being provided to the mobile unit users. Therefore, it is unclear of what feature of this new database the applicant uses in the present invention and how it is used.

7. Claims 41, 44, and 45 recite the limitation "The geographic-based communications system" in line 1. There is insufficient antecedent basis for this limitation in the claim. Each claim is dependent upon a claim with the system described as "A distributed communication system". Corrective action is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

9. Claims 1-4, 7-9, 13-17, 21-28, 31, 32, 34-39, and 42-45 rejected under 35 U.S.C. 102(e) as being anticipated by Lawlor et al (6,202,054).

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Claims 1, 13, 14, 23-25, 37, 39, 42, and 43: Lawlor discloses a system and method for providing information to users of mobile (portable) units, comprising:

- a. Transmitting identification information from the mobile unit to an access point (col 34, lines 57-64);
- b. Detecting the mobile unit by the access point based on the identification information transmitted by the mobile unit (col 34, line 64 - col 35, line 5);
- c. Determine past transactions of the user of the mobile unit (col 13, lines 42-59; col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29); and
- d. Transmitting information to the mobile unit based/dependent upon the past transaction information of the user of the mobile unit (col 13, lines 42-59; col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29).

Claims 2, 15, 26, and 44: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 43 above; and further discloses that the past transactions include the requirements, preferences and/or habits of the user (col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 39, lines 5-29).

Claims 3, 16, and 27: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, and 23 above; and further discloses that the past transaction information includes information from which probable future actions by the users may be extrapolated (col 30, line 50 - col 31, line 15 and col 39, lines 5-29). Lawlor discloses the past transaction information including information such as the user's spending patterns. Spending

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pattern information is used extensively by the retail arts to project future spending by the individual. Therefore, the inclusion of this type of information in Lawlor reads on the above limitation.

Claims 4, 17, 28, and 45: Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 43 above; and further discloses that the past transaction information includes information about past commercial activities of the user (col 15, lines 36-49 and col 30, line 55 - col 31, line 15).

Claims 7 and 8: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 1 above; and further discloses a plurality of information providers who provide the information based on the past transactions of the user (col 17, lines 62-67 and col 18, lines 12-17).

Claim 9: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 8 above, and further discloses that the advertisement (information) could be for a loan (i.e. from a bank or financial institution) or “used to advertise any good or service.” (col 39, lines 13-22).

Claims 21, 22, 34, 35, 36, and 38: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claims 13 and 23 above; and further discloses that the information comprises promotions/advertisements based on the past transactions of the user (col 13, lines 42-59; col 15, lines 36-49; and col 30, line 50 - col 31, line 15).

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Claim 31: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 23 above, and further discloses the user of the mobile device transmitting an inquiry and the information provider transmitting information in response to the inquiry (col 15, lines 36-49; col 30, line 55 - col 31, line 15; and col 33, lines 58-66).

Claim 32: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 23 above, and further discloses the information provider determines if a service is required and provides the service to the user upon detection of the user within the monitored area (col 15, lines 36-49; col 30, line 55 - col 31, line 15; col 33, lines 58-66; and col 50, lines 50-60).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (6,202,054).

Claim 10: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 8 above, but does not disclose a management information

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database which stores information about the topography of the network, its elements, links, performance, or trends. As discussed in the 35 U.S.C. 112, second paragraph, rejection of this claim above, the claimed invention makes no use of such a database, but merely states that one is present in the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made that any number of databases, each storing any type of information, can be present in a computer system. Therefore, it would have also been obvious to store a database of information pertaining to the network's topography, elements, links, performance, and/or trends in Lawlor's system. One would have been motivated to store such a database in order to allow the system manager to better control the system.

12. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (6,202,054) as applied to Claim 1 above, and further in view of Rudow et al (6,236,360).

Claims 11 and 12: Lawlor discloses a system and method for providing information to users of mobile (portable) units as in Claim 1 above, but does not explicitly disclose that the information is dependent upon the location of the mobile unit which is determined by the arrangement of the access points. Rudow discloses a similar system of providing information to golfers on a golf course which uses the Global Positioning Satellite (GPS) system and local transceivers to determine the exact location of the golf cart (or hand held device) on the golf course and then transmits information (such as distance to hole, recommended golf club to use, etc.) to the golfer based on the location of the golf cart (col 6, lines 53-55). The system also can

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be used to transmit other information to the golfer, such as advertisements and personal messages. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the location from which the portable device in Lawlor is transmitting and to base the information transmitted to the device on the location. One would have been motivated to base the transmitted information on the location of the portable device in order to better target the advertisement to the user as described by Lawlor (col 30, line 55 - col 31, line 15).

13. Claims 5, 6, 18-20, 29, 30, 33, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawlor et al (6,202,054) in view of Farmakis et al (5,714,948).

Claims 5, 6, 18-20, 29, 30, 33, 40, 41: Lawlor disclose a system and method for providing information to users of mobile (portable) units as in Claims 1, 13, 23, and 39 above, and further discloses the information being advertisements pertaining to banking services, loans, or any other good or service as discussed in Claim 9 above. However, Lawlor does not explicitly disclose where the access points are located or that the information is a travel itinerary. Farmakis discloses a similar system and method for providing information to users of mobile units (col 4, lines 32-35; col 9, lines 60-62; and col 16, line 67 - col 17, line 10) in which the access points are located in an airport (col 13, lines 7-33). It would have been obvious to one having ordinary skill in the art at the time the invention was made that the location of the access points and information provided would depend on the type of information providers in the system. In Rudow, the access

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points are located around the golf course and the information being provided pertains to the golfer's game (i.e. distance from hole, etc.) or related advertisements/services (i.e. golf ball sale in clubhouse or personal message to golfer). In Farmakis the access points are located around an airport and the information being provided pertains to pilot instructions and information related to traffic control, both on the ground and in the air. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to locate the access points in particular areas, such as airports or hotels, and to provide information about goods or services of the information providers, such as travel agencies/airlines (travel itineraries), hotel or car rental information/reservations, etc. One would have been motivated to locate the access points in airports or hotels in order to target customers of such establishments, especially if the information provider was the hotel, an airline, car rental agency, or taxi service.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Rudow et al (6,236,940) discloses a system and method for providing information to users of mobile units on a golf course. This reference could be used in a 35 U.S.C. 102 rejection of Claims 1, 11-13, 21-25, 31, 32, 34-39, and 42 above, and in support of a 35 U.S.C. 103 rejection of all other pending claims.

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b. Cubley et al (5,122,795) discloses a system and method for providing information to pagers located nationwide. This reference could be used in support of a 35 U.S.C. 103 rejection of the claims which include the feature of targeting the information based on the location of the mobile unit.

c. Gray (5,602,843) discloses a system and method for providing information to mobile units (wireless telephones). This reference could be used in support of a 35 U.S.C. 103 rejection of the claims which include the feature of targeting the information based on the location of the mobile unit.

d. Atalla et al (4,536,647) discloses a system and method for providing information (banking services) to mobile units (pocket banking terminals). This reference could be used in support of a 35 U.S.C. 103 rejection of all pending claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

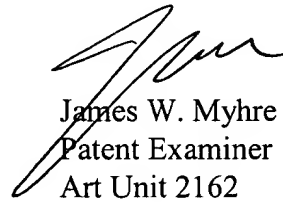
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal of Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240. Draft faxes may also be submitted directly to the examiner at (703) 746-5544.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.



JWM
January 2, 2002



James W. Myhre
Patent Examiner
Art Unit 2162